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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,661	03/24/2004	Richard E. Staerzl	M09741	4313
7590	03/20/2006			
William D. Lanyi Mercury Marine W6250 Pioneer Road P.O. Box 1939 Fond du Lac, WI 54936-1939			EXAMINER	SWINEHART, EDWIN L
			ART UNIT	PAPER NUMBER
			3617	
DATE MAILED: 03/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/807,661	STAERZL, RICHARD E.	
	Examiner	Art Unit	
	Ed Swinehart	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 February 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/2006 has been entered.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 14 and 29, the relationship of "a housing" in the "disposing" step, to the housing previously recited has not been made clear.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-14-23,29-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Staerzl '669.

Staerzl '669 teaches the claimed method, including the application of a conductive coating onto the outer surface of a propulsion unit lower unit/housing, and

ohmically connecting the coating to a source of electrical power. The lower unit contains shafts, gears and bearings as are notoriously well known in the art. The lower portion thereof inherently being the gear case.

Re claim 15, "providing..." does no more than set forth pure structure, and as such fails in this instance to further limit the method.

Re claims 5-8,19-23, and 31-34 such set forth pure structure, in this instance carrying no weight in these method claims.

Re claim 16, the presence of the propeller will inherently cause same to act as cathode as the paint is positively charged. It would of course have been obvious to one of ordinary skill in the art at the time of the invention to construct the propeller of Staerzl '669 from a metallic conductive material as is notoriously old and well known in the art.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staerzl '669 in view of Staerzl '460.

Staerzl '669 fails to disclose measurement of voltage as claimed.

Staerzl '460 teaches sensing of voltage at reference point **13**, and basing control of the device upon the sensed voltage.

It would have been obvious to one of ordinary skill in the art at the time of the invention to control the system of Staerzl '669 based upon measured potential as taught by Staerzl '460.

Such a combination would have been desirable at the time of the invention so as to provide accurate control thereof.

8. Claims 20,21,24 and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staerzl '669 in view of Moreland et al.

Staerzl '669 fails to discuss the composition of his conductive paint.

Moreland et al. teaches cathodic protection using a polymer based paint with graphite fibers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a polymer based conductive paint as the paint of Staerzl '669 as taught by Moreland et al.

9. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staerzl '669 in view of Moreland et al. as applied to claim 24 above, and further in view of Staerzl '460.

Staerzl '460 is applied as above.

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

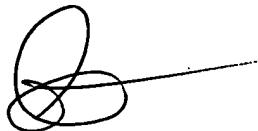
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ed Swinehart whose telephone number is 571-272-

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6688. The examiner can normally be reached on Monday through Thursday 6:30 am to 2:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ed Swinehart
Primary Examiner
Art Unit 3617